REMARKS

The Office Action mailed January 7, 2009, has been received and reviewed. Claims 1-28 are currently pending in the application. Claims 1-28 stand rejected. Applicant has amended claims 1, 22, 25, 27 and 28, and respectfully requests reconsideration of the application as presented herein. No new matter has been added.

Claim Rejections under 35 U.S.C. § 103

Claims 1-28 were rejected as being unpatentable over U.S. Pat. Pub. No. 2003/0017833 to Forrester ("Forrester") in view of U.S. Patent 6,985,712 to Yamakawa *et al.* ("Yamakawa"). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-28 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

Regarding independent claim 1 and claims 2-21 depending therefrom, independent claim 22 and claims 23 and 24 depending therefrom, independent claim 25 and claim 26 depending

therefrom, and independent claims 27 and 28, Applicant's independent claims include claim limitations not taught or suggested in the cited references.

The Office Action in the Response to Arguments section alleges:

> The applicant argued that Forrester's system "never transmits and receives the same band over different antenna" (See Remark pages 9-10). The examiner respectfully disagrees with the applicant's argument. ***The limitation "transmits and receives the same band over different antenna" is not recited in corresponding independent claims as argued.*** (Office Action, p. 6; emphasis added).

Applicant respectfully disagrees and has yet further amended Applicant's claims to even yet further point out that such limitations are, in fact, present in Applicant's claimed invention. Specifically, Applicant's amended independent claims 1, 22, 25, 27 and 28 each recite, in part, "***transmitting a second TDMA frequency band using [a] first antenna***" and "***receiving the second TDMA frequency band using [a] second antenna***". Clearly Applicant's claim elements do recite "transmit[ting] and receiv[ing] the same band [e.g., second TDMA frequency band] over different antenna [e.g., first and second antennas]" as alleged as not being taught in the present Office Action, the previous Office Action, and even the January 31, 2008 Office Action.

Furthermore, Applicant's previous Amendment of May 29, 2008 and the Amendment of October 30, 2008 added claim elements to this effect. Accordingly, Applicant's present Amendments merely further recite the claim elements present in at least both of the previous amendments. Accordingly, the present amendments cannot be regarded as raising new issues and requiring a further search and, therefore, should be entered. Specifically, Applicant's previous amendments to Applicant's independent claim 1, for example, recited, "a first section coupled to ***a first antenna … for transmitting a second TDMA frequency band***; and … ***a second antenna … for receiving the second TDMA frequency band***". Applicant's other independent claims 22, 25, 27 and 28 included similar claim limitations. Accordingly, Applicant's new amendments cannot be regarded as requiring a further search and must be entered.

Furthermore, the Office Action in the Response to Arguments section additionally alleges:

> [T]he modified Forrester's system does still read on the claimed limitations (based on the claimed language) since the ***applicant has never claimed the first antenna "for only transmitting the second TDMA frequency band" as well as the second***

> ***antenna "for only receiving the second TDMA frequency band".*** (Office Action, pp. 6-7; emphasis added).

Applicant respectfully disagrees and has yet further amended Applicant's claims to even yet further point out that such limitations are, in fact, present in Applicant's claimed invention. Specifically, Applicant's amended independent claims 1, 22, 25, 27 and 28 each recite, in part, "***transmitting a second TDMA frequency band using [a] first antenna***" and "***receiving the second TDMA frequency band using [a] second antenna***". Clearly Applicant's claim elements do recite ***the first antenna for transmitting the second TDMA frequency band as well as the second antenna for receiving the second TDMA frequency band*** as alleged as not being taught in the present Office Action.

Applicant respectfully asserts that neither Forrester nor Yamakawa, either individually or in any proper combination, teach or suggest Applicant's invention as presently claimed in Applicant's independent claims. Generally, Forrester teaches transmitting and receiving a first cellular frequency band using a transmitter (Fig. 5, input to 270) and a first receiver (Fig. 5, beginning at 290) coupled to a "main antenna" (Fig. 5, 110) (e.g., first section/first antenna) and merely "scanning" (i.e., receiving) a second cellular frequency band using a second receiver (Fig. 5, beginning at 450) coupled to an "auxiliary antenna" (Fig. 5, 120a) (e.g., a second section/second antenna). In Forrester, when a second cellular frequency band as received on Forrester's second receiver (450) coupled to the auxiliary antenna (120a) is a "better" frequency band, then Forrester reconfigures the transmitter (input to 270) and a first receiver (beginning at 290) coupled to the "main antenna" (110) to transmit and receive the second cellular frequency band while reconfiguring the second receiver (beginning at 450) coupled to the "auxiliary antenna" (Fig. 5, 120a) to "scan" (i.e., receive) other frequency bands.

Specifically, Forrester teaches:

> [0045] In an exemplary embodiment, the ***main antenna system 240 gives priority to two-way communications*** with a wireless communications network. However, ***while the wireless communications device 100 is in two-way communications, the wireless communications device 100 can assign a lower priority to scanning other channels, bands or modes via the first auxiliary antenna 120a.*** A scanning order for channels, bands or modes is determined by the main controller 210 via, for example, a list stored in a memory of the main controller 210. The scanning is achieved, for example, by the selector module 190 as controlled by the main controller 210. Decisions as to which

> channels, bands or modes to scan can also be determined in light of information received via the line or bus 230. ***If the main controller 210 determines that there is a much better channel, band or mode available, the main controller 210 can switch the main antenna system 240 to the better channel, band or mode.*** Such scanning can occur, for example, at periodic intervals or as a function of a triggering condition such as, for example, reaching a threshold signal strength. (Emphasis added.)

Therefore, Forrester's system ***never transmits and receives the same band over different antennas.*** Accordingly, Forrester does not teach "***transmitting a second TDMA frequency band using [a] first antenna***" and "***receiving the second TDMA frequency band using [a] second antenna***" as claimed in Applicant's independent claims 1, 22, 25, 27 and 28.

The Office Action cites Yamakawa for merely suggesting "an antenna switch … comprising a SP3T switch …." (Office Action, p. 3).

Therefore, since neither Forrester nor Yamakawa teach or suggest Applicant's claimed invention, these references, either individually or in any proper combination, **cannot** render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in independent claims 1, 22, 25, 27 and 28. Accordingly, Applicant respectfully requests the rejection of independent claims 1, 22, 25, 27 and 28 be withdrawn.

The nonobviousness of independent claim 1 precludes a rejection of claims 2-21 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See* In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 1 and claims 2-21 which depend therefrom.

The nonobviousness of independent claim 22 precludes a rejection of claims 23 and 24 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See* In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 22 and claims 23 and 24 which depend therefrom.

The nonobviousness of independent claim 25 precludes a rejection of claim 26 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See* In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also*

MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 25 and claim 26 which depends therefrom.

ENTRY OF AMENDMENTS

The proposed amendments to claims 1, 22, 25, 27 and 28 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues that would require further consideration or a search. Additionally as stated above, these claim limitations have been before the Examiner since at least May 29, 2008 and therefore cannot be interpreted as raising new issues.

CONCLUSION

Claims 1-28 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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